

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HIROSHI ISHIBE,  
MANABU INOUE,  
TETSURO KANBARA,  
KATSUYUKI NANBA,  
HIROKAZU YAGURA,  
and  
TAKEHIRO KATOH

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Appeal No. 1999-1694  
Application No. 08/474,903

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ON BRIEF

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Before HAIRSTON, RUGGIERO, and GROSS, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 18-39 and 41-62. Claims 1-17 and 40 have been canceled. The Examiner, after reconsideration, indicates (Answer, page 2) that claims 30-38, 47-50, and 52-62 are allowed, and that claim 43 is allowable subject to being rewritten in independent form to

Appeal No. 1999-1694  
Application No. 08/474,903

include all the limitations of its parent and any intervening claims. Accordingly, only the rejection of claims 18-29, 39, 41, 42, 44-46, and 51 is before us on appeal.<sup>1</sup>

The disclosed invention relates to an image reproducing device in which still images, such as images on developed film, are converted into electrical signals and displayed on output devices such as a television screen. A particular emphasis of the claimed invention is directed to the processing of image data in accordance with the format of the film on which the images have been recorded.

Claim 18 is illustrative of the invention and reads as follows:

18. A still image reproducing apparatus for reproducing a plurality of still images each having corresponding image information, said apparatus comprising:

an image sensor which senses said still images;

a memory which stores still image data sensed by said image sensor;

an information reader which reads said information corresponding to said image;

a reproducing device which reproduces said still image data stored in said memory; and

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<sup>1</sup> In a communication dated March 29, 1999 (Paper No. 25), the Examiner indicated that claim 41 was inadvertently omitted from the list of rejected claims in the Answer.

Appeal No. 1999-1694  
Application No. 08/474,903

a controller which controls the selection of image data sensed by said image sensor, on the basis of said information read by said information reader.

The Examiner relies on the following prior art:

Wada et al. (Wada)	5,258,859	Nov. 02, 1993
		(filed Jul. 24, 1990)

Claims 18-29, 39, 41, 42, 44-46, and 51 stand rejected under 35 U.S.C. § 102(b) as anticipated by Wada.<sup>2</sup>

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs<sup>3</sup> and Answer for the respective details.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of anticipation relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments

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<sup>2</sup> Although not contested by Appellants, it is apparent that Wada does not qualify as prior art under 35 U.S.C. § 102(b) since its issue date of November 2, 1993 is after Appellants' effective filing date of November 20, 1992. We find no information on the record, however, which would disqualify Wada, which has a U.S. filing date of July 24, 1990, under 35 U.S.C. § 102(e).

<sup>3</sup> The Appeal Brief was filed August 31, 1998 (Paper No. 22). In response to the Examiner's Answer dated November 17, 1998 (Paper No. 23), a Reply Brief (Paper No. 24) and Supplemental Reply Brief (Paper No. 26) were filed January 14, 1999 and May 25, 1999, respectively, which have been acknowledged and entered by the Examiner.

Appeal No. 1999-1694  
Application No. 08/474,903

set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the Wada reference fully meets the invention as set forth in claims 18-29, 39, 42, 44-46, and 51. We reach the opposite conclusion with respect to claim 41. Accordingly, we affirm-in-part.

Appellants nominally indicate at page 4 of the Brief that all of the appealed claims stand or fall separately. Separate arguments for patentability in the Briefs, however, have been made only for rejected independent claims 18, 24, 39, and 51, and dependent claim 41. We will consider the appealed claims separately only to the extent that separate arguments are of record in this appeal. Any dependent claim not argued separately will stand or fall with its base claim. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

We initially consider the Examiner's 35 U.S.C. § 102 rejection of independent claims 18 and 24 as being anticipated by Wada. We note that anticipation is established only when a single prior art reference discloses, expressly or under the

principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The relevant portion of independent claim 18 (similarly recited in independent claim 24) requires " . . . a controller which controls the selection of image data sensed by said image sensor, on the basis of said information read by said information reader."

With respect to claims 18 and 24, the Examiner has indicated (Answer, page 3) how the various limitations are read on the disclosure of Wada. In particular, the Examiner points to the illustration in Figure 13 of Wada along with the accompanying description of the illustrated controller sections 102 and 104 beginning at column 9, line 29.

Appellants' arguments in response (Brief, pages 5 and 6; Reply Brief, page 2) initially assert that Wada lacks a disclosure of the selection of image data sensed by the CCD image sensor since the sequence controller 102 referred to by the

Appeal No. 1999-1694  
Application No. 08/474,903

Examiner controls only when the image sensor is sequenced to sense image data. In a similar vein, Appellants contend that the trimming magnification discussed in Wada does not relate to the selection of image data from the CCD but, rather, to the control of the optical system to adjust the image size projected on to the CCD image sensor.

After careful review of the Wada reference in light of the arguments of record, we are in agreement with the Examiner's position as stated in the Answer. In our view, Appellants' arguments ignore a clear disclosure in Wada of the selection and processing of information read out from the CCD image sensor 1. For example, in discussing image information converting section 101 which includes an image focusing control portion, Wada also indicates that this converting section includes a portion " . . . for converting information received at the image pickup element CCD 1 . . . . " (Wada, column 9, lines 33-35). Further, a detailed diagram of the image information converting circuit is provided in Figure 14 which, inter alia, shows a processing path from the output of the CCD 1 leading to the development of the video signal output. Examples of the processing of the image sensor output responsive to film information read by an

Appeal No. 1999-1694  
Application No. 08/474,903

information reader, which satisfy the claimed "selection of image data" requirement, are provided in the description beginning at column 10, line 41 of Wada.

In view of the above discussion, since all of the claimed limitations are present in the disclosure of Wada, the Examiner's 35 U.S.C. § 102 rejection of independent claims 18 and 24, as well as dependent claims 19-23 and 25-29 not separately argued by Appellants, is sustained.

Turning to a consideration of the Examiner's 35 U.S.C. § 102 rejection of independent claims 39 and 51, as well as dependent claims 42-46 for which Appellants have provided no separate arguments for patentability, we sustain this rejection as well. The language of independent claim 39, instead of reciting the selection of sensed image data as in claims 18 and 24, requires a data processor which " . . . varies the amount of image data . . . " sensed by the image sensor. Similarly, independent claim 51, rather than reciting the selection of sensed image data, sets forth a controller which " . . . controls sampling of image data . . . . " In our view, the processing feature of varying the amount of image data sensed by an image sensor, as well as the sampling of such sensed image data, to provide an image output is clearly disclosed in the description of Figure 14 beginning at

column 10, line 41 of Wada. Wada further provides for the variation of the amount of image data to be output as discussed in the description of the zooming and panning operations in which data is continuously read out of the CCD 1. (Wada, column 15, lines 5-15). We further note that, with regard to claim 51, we find Appellants' arguments to the effect that Wada does not disclose the controlling of the sampling rate of the sensed image data to be unpersuasive since there is no sampling "rate" requirement in the claim.

Lastly, while we found Appellants' arguments to be unpersuasive with respect to the Examiner's 35 U.S.C. § 102 rejection of claims 18-29, 39, 42, 44-46, and 51, we reach the opposite conclusion with respect to dependent claim 41. Dependent claim 41 is directed to the feature of providing for the variation of the data amount from the image sensor by skipping a part of the input image data. We find no disclosure in Wada, and the Examiner has pointed to none, that would satisfy this claim requirement. We would also point out that this same data skipping feature is present in claims 38 and 55, which the Examiner has indicated to be allowable. Accordingly, since all



Appeal No. 1999-1694  
Application No. 08/474,903

of the claimed limitations are not present in the disclosure of Wada, the Examiner's 35 U.S.C. § 102 rejection of claim 41 is not sustained.

In summary, with respect to the Examiner's 35 U.S.C. § 102 rejection of the appealed claims, we have sustained the rejection of claims 18-29, 39, 42, 44-46, and 51, but have not sustained the rejection of claim 41. Therefore, the Examiner's decision rejecting claims 18-29, 39, 41, 42, 44-46, and 51 is affirmed-in-part.

Appeal No. 1999-1694  
Application No. 08/474,903

No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

AFFIRMED-IN-PART

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
	)	
	)	
JOSEPH F. RUGGIERO	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
ANITA PELLMAN GROSS	)	
Administrative Patent Judge	)	

JFR:hh

Appeal No. 1999-1694  
Application No. 08/474,903

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